



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,045	09/12/2003	Peter James Tormey	MOER-01000US0	6740
28554	7590	02/14/2006		
VIERRA MAGEN MARCUS & DENIRO LLP 575 MARKET STREET SUITE 2500 SAN FRANCISCO, CA 94105			EXAMINER SHAH, AMEE A	
			ART UNIT	PAPER NUMBER
			3625	
DATE MAILED: 02/14/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,045

Applicant(s)

TORMEY ET AL.

Examiner

Amea A. Shah

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 24-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-59 are pending in this action.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23, drawn to a method for gathering information on the Internet including receiving electronic requests for desired products or services, determining potential vendors, outputting emails to the vendors, searching the Internet, extracting emails from the searching, receiving emails from interested vendors, and outputting vendor information to the users, classified in class 705, subclass 26.
- II. Claims 24-29 drawn to a method for conducting commerce on the Internet, including providing a customer agent with a keyword search field, transaction type selector and descriptor file generator and providing a control server with a receiver for query results and email generator, classified in class 705, subclass 26.
- III. Claims 30-59, drawn to a method, system and program for conducting business over the Internet including generating a descriptor file, encrypting the descriptor file, receiving from vendors information, and outputting the information to users, classified in class 705, subclass 50.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be

Art Unit: 3625

separately usable. In the instant case, invention II has separate utility such as providing a customer agent, not required by inventions I or III, and invention III has separate utility such as generating a descriptor file and encrypting the descriptor file, not required by invention I. *See* MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art because of their recognized divergent subject matter and/or different classification, the search required for Group II is not required for Groups I and III, and the search required for Group III is not required for Group I, restriction for examination purposes as indicated is proper.

During a telephone conversation with Larry Vierra on February 2, 2006, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-59 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) for the following reasons:

- (1) Reference character “304” has been used to designate both customer device and merchant.
- (2) They do not include the following reference sign(s) mentioned in the description: 365, 366 and 1026.
- (3) They include the following reference character(s) not mentioned in the description: 313, 208, 640, 1410, and 1510.
- (4) Figures 1A and 1B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. *See* MPEP § 608.02(g).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d) in the top margin or in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The use of numerous trademarks, such as GOOGLE, YAHOO, AMAZON, MICROSOFT, BLACKBERRY, and many others, has been noted throughout this application. The trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 11 and 15 include the limitation “wherein the step of receiving [of Claim 10]...” However, there are two receiving steps cited in Claim 10. Even after a review of the specification, it is not clear to one of ordinary skill in the art as to which receiving step Claims 11 and 15 refer. Based on the limitations of Claims 11 and 15 relating to a descriptor file regarding product specifications, the Examiner interprets this claim to be based on the step recited in Claim 10 of receiving emails from vendors, and will examine accordingly. Because claims 12-14 and

Art Unit: 3625

16 are dependencies of claims 11 and 15, they inherit the same deficiencies, are rejected on the same bases, and are interpreted in the same manner.

Examiner Note

Claims 1-23 are examined in this action.

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 14, 17 and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Elms et al., U.S. Pat. App. Pub. No. 2002/0072992 A1 (hereinafter referred to as “Elms et al.”).

Referring to claim 1. Elms et al. discloses a method for gathering information on the Internet, comprising:

- receiving an electronic request from one or more users for a specification of a product or service desired by the one or more users via an input form provided by a server (page 2, ¶0033 – note the electronic request is the buyer query);
- determining vendors who potentially possess the good or service of interest to the one or more users (pages 2-3, ¶0034 – note the determination of vendors is performed by searching the database); and
- outputting e-mails to said vendors requesting information about said good or service (page 3, ¶0040 – note the information request is contained in the folder contents).

Referring to claim 2. Elms et al. further discloses the method of claim 1 wherein the step of determining comprises searching a database having at least a relationship between key words searched by the one or more users and a set of vendors (pages 2-3, ¶¶0033-0034).

Referring to claim 3. Elms et al. further discloses the method of claim 1 wherein the step of determining comprises searching the Internet using a commercially available search engine (page 2-3, ¶¶0033-0034 – note the search engine is inherently commercially available).

Referring to claim 4. Elms et al. further discloses the method of claim 3 further including the step of extracting emails from a set of results of said searching (page 3, ¶¶0044-0052 – note the extraction of emails is the receiving of emails from vendors and updating the project folder).

Referring to claim 5. Elms et al. further discloses the method of claim 1 wherein the step of determining comprises searching a database having at least a relationship between key words searched by the one or more users and a set of vendors and searching the Internet using a commercially available search engine (pages 2-3, ¶¶0034 – note the search engine searches a database).

Referring to claim 6. Elms et al. further discloses the method of claim 1 further including the step of receiving e-mails from vendors interested in selling the good or service to the one or more users (Fig. 5 and pages 3-4, ¶¶0049, 0077-0080).

Referring to claim 7. Elms et al. discloses the method of claim 6 further including the step of outputting vendor information to the one or more users (Fig. 5 and page 4, ¶¶0076-0080).

Referring to claim 8. Elms et al. discloses the method of claim 6 further including the step of updating a datastore with weighting information on vendors (page 5, ¶¶0091-0095 – note the weighting information is the satisfaction/ranking questions).

Referring to claim 9. Elms et al. discloses the method of claim 1 wherein the method is performed on a server coupled to the Internet (page 2, ¶¶0023-0024).

Referring to claim 10. Elms et al. discloses a method for conducting commerce, comprising:

- receiving requests from one or more users comprising a list of hits and a specification of a product or service desired by the one or more users (page 3, ¶¶0035-0037 – note the request is the buyer selection from a list of search results one or more vendors for the product/service);
- outputting e-mails to vendors identified in the list as potentially possessing the good or service for sale to the one or more users (page 3, ¶0040);
- receiving e-mails from vendors interested in selling the good or service to the one or more users (page 3, 0049); and
- outputting vendor information to the one or more users (page 3, ¶0052).

Referring to claim 11. Elms et al. further discloses the method of claim 10 wherein the step of receiving includes receiving a descriptor file containing the product specification (page 3, ¶0049 – note the descriptor file is document relating to the dialog).

Referring to claim 14. Elms et al. further discloses the method of claim 10 wherein said steps are performed on a server coupled to the Internet (page 2, ¶¶0023-0024).

Referring to claim 17. Elms et al. discloses the method of claim 10 wherein the step of outputting e-mails is performed by a user device (page 2, ¶0025 – note the user device can be a personal digital assistant).

Referring to claim 19. Elms et al. discloses the method of claim 10 wherein said step of receiving e-mails from vendors is performed by the server (page 2, ¶¶0024-0025).

Referring to claim 20. Elms et al. discloses the method of claim 10 wherein said step of receiving e-mails from vendors is performed by a user device (page 2, ¶¶0024-0025).

Referring to claim 21. Elms et al. discloses the method of claim 10 wherein the step of outputting vendor information includes outputting each e-mail received from vendors (Fig. 5 and page 4, ¶¶0076-0080).

Referring to claim 22. Elms et al. discloses the method of claim 10 wherein the step of outputting vendor information includes outputting a summary of the e-mail received from vendors (page 4, ¶¶0076-0080).

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 13, 15, 16, 18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elms et al. in view of Friedman et al., U.S. Pat. App. Pub. No. 2003/0208556 A1 (hereinafter referred to as “Friedman et al.”).

Referring to claims 12 and 13. Elms et al. discloses the method of claim 11, as discussed above, but does not explicitly disclose wherein the descriptor file is formatted in XML nor where the descriptor file is encrypted. Friedman et al., in the same field of endeavor of e-shopping, discloses a method for purchasing and sending greeting cards including wherein a descriptor file, i.e. information relating to the product, is transmitted by messages formatted in XML and can be encrypted (pages 8 and 10, ¶¶0082 and 0100). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Elms et al. to include the teachings of Friedman et al. to allow for the descriptor file to be formatted in XML or to be encrypted. Doing so would allow for information to be transferred in a variety of formats, increase compatibility with user devices, and provide security against non-authorized persons, as implied by Friedman et al. (pages 8 and 10, ¶¶0082 and 0100).

Referring to claim 15. Elms et al. discloses the method of claim 14, as discussed above, but does not disclose wherein the step of receiving comprises receiving an e-mail including an encrypted descriptor file from a customer agent on a user device. Friedman et al., in the same field of endeavor of e-shopping, discloses a method for purchasing and sending greeting cards including the step of receiving an email including an encrypted descriptor file from a customer agent on a user device (pages 8 and 10, ¶¶0082 and 0100 – note the customer agent is the inventive website). At the time of the invention, it would have been obvious to a person of

Art Unit: 3625

ordinary skill in the art to have modified the system of Elms et al. to include the teachings of Friedman et al. to allow for the step of receiving an email to include an encrypted descriptor file from a customer agent on a user device. Doing so would provide security against non-authorized persons, as implied by Friedman et al. (pages 8 and 10, ¶¶0082 and 0100).

Referring to claim 16. Elms et al. in view of Friedman et al. discloses the method of claim 15, as discussed above, wherein the descriptor file includes e-mail addresses extracted from the list of hits (pages 5-6, ¶0068 – note the email addresses are included in the descriptor file based on being stored in the database). Doing so would allow for the email addresses of the vendors to be readily available for easier and faster communication, leading to faster and more efficient order processing.

Referring to claim 18. Elms et al. discloses the method of claim 10, as discussed above, but does not disclose wherein the step of outputting e-mails includes providing an intermediary e-mail address not associated with said one or more users. Friedman et al., in the same field of endeavor of e-shopping, discloses a method for purchasing and sending greeting cards including the step of outputting e-mails that provide an intermediary e-mail address not associated with the user(s) (page 10, ¶0100 – note the intermediary e-mail address is that of the inventive system). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Elms et al. to include the teachings of Friedman et al. to allow for the step of outputting e-mails that provide an intermediary e-mail address not associated with the user(s). Doing so would provide security for users against unwanted solicitation by vendors.

Referring to claim 23. Elms et al. discloses the method of claim 10, as discussed above, but does not explicitly disclose the further steps of receiving a request from a user to purchase a product or service and performing a monetary exchange between the user and the vendor.

Friedman et al., in the same field of endeavor of e-shopping, discloses a method for purchasing and sending greeting cards including the steps of receiving a request from a user to purchase a product or service and performing a monetary exchange between the user and the vendor (pages 7-8, ¶0080). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Elms et al. to include the teachings of Friedman et al. to allow for the steps of receiving a request from a user to purchase a product or service and performing a monetary exchange between the user and the vendor. Doing so would allow for transactions to be consummated and business conducted, increasing commerce.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Spencer, U.S. Pat. No. 6,356,909 B1, discloses an integrated web-based system for generating electronic requests for proposal wherein a website is used to enable users to request specific information on goods and services from specific vendors, to respond to requests, and informing potential vendors when requests are complete (see, e.g., cols. 5-14).

(2) Ogino et al., U.S. Pat. App. Pub. No. 2003/0097305 A1, discloses an electronic commerce system for enabling business transactions between customers and suppliers (see, e.g., pages 1, 4-7).

(3) Geranio, U.S. Pat. App. Pub. No. 2004/0002871 A1, discloses an integrated property database and search engine wherein an inquiry is sent from a buyer, suitable properties are searched, and seller offers with information is emailed to the seller (see, e.g., pages 2-4).

(4) Hwang, KR 2002040422A, discloses a method for trading real estate wherein a management server searches for properties based on the buyer's criteria, and transfers search results to the buyer, including email address of seller, as well as property information (see Abstract).

(5) The website www.craigslist.org, captured via the WayBackMachine, available at www.archive.org, and dated Oct. 17, 2002, shows a website that discloses the method of claims 1-9 whereby a user searches for a product by keyword, the search engine finds sellers of that product, displaying those sellers to the user, submitting an email to the seller regarding the user's interest in the product (see pages 1-9).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAS

February 7, 2006


Y.C. Gart
Primary Examiner